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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/510,580	02/22/2000	Richard A. Leeds	59622-2	4232
22504 7590 06/06/2007 DAVIS WRIGHT TREMAINE, LLP 1201 Third Avenue, Suite 2200 SEATTLE, WA 98101-3045			EXAMINER VIG, NARESH	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 06/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/510,580	<b>Applicant(s)</b> LEEDS, RICHARD A.	
	<b>Examiner</b> Naresh Vig	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 67-75 and 92-98 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 67-75 and 92-98 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20050506; 20051007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Prior office action mailed 15 December 2006 has been vacated because wrong office action was mailed to the applicant. Claims 67 – 75 and 92 – 98 are pending for examination.

### ***Response to Arguments***

Applicant's arguments and concerns are for newly added claims 67 – 75 and 92 – 98 which are responded to in this office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 67 – 75 and 92 – 98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant is arguing and claiming reverse engineering to determine user location as their claimed invention which is also noted in the interview summary mailed 19 April 2007. Specification originally filed 22 February 2000 does not have support to enable one of ordinary skill in the art to use applicant's claimed and argued invention to use DNS to determine current location of the user.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 67 – 75 and 92 – 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. US Patent 6,332,127 hereinafter known as Bandera in view of Griffiths et al. US Patent 6,28,6045 hereinafter known as Griffiths.

Regarding claims 67 and 92, As best understood by examiner, Bandera teaches system for selecting an advertising object to be displayed within a web page requested by a user based on the geographic location of the user and/or on the time of day. Bandera teaches merchandise or service database; a shopper data collector configured to collect and analyze data from the remote computers of shoppers to determine

information usable to formulate tailored store screens for shoppers; a presentation formulator configured to formulate store screens to be displayed on the shopper's computer during the current communication; and a web server configured to communicate with the remote computers of shoppers and to send the tailored store screens to the remote computers.

Bandera does not explicitly teach a presentation formulator configured to formulate tailored store screens to be displayed on the remote computers of shoppers. However, Griffiths teaches that it is old an known to create and send tailored store screens to be displayed on the remote computers of users.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bandera as taught by Griffiths to to enhance the efficacy of advertising to users accessing the web.

Regarding claim 68 – 71, Bandera in view of Griffiths teaches capability wherein the data collected and analyzed by the shopper data collector from the shopper's computer during the current communication includes the search request the shopper entered into the shopper's computer to navigate to the host system to initiate the current communication, without the host system requiring the shopper to take any direct action to instruct the shopper's computer to provide such information to the host system and without the host system having such information prior to the current communication, and wherein the one or more tailored store screens to be displayed on the shopper's computer during the current communication are formulated by the presentation

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formulator by including and excluding selected information in at least one of the merchandise database and the services database at least in part upon the search request the shopper entered into the shopper's computer to navigate to the host system to initiate the current communication, the prior web site from which the shopper navigated to the host system to initiate the current communication and the software installed on the shopper's computer at the time of the current communication, as determined by the shopper data collector.

Regarding claim 72, Bandera in view of Griffiths teaches capability wherein the location of the shopper's computer at the time of the current communication, as determined by the shopper data collector, is used by the shopper data collector to determine for the current communication particular traits, habits, or interests of the shopper or other pertinent shopper information, then used by the presentation formulator to formulate the one or more tailored store screens to be displayed on the shopper's computer during the current communication.

Regarding claim 73, Bandera in view of Griffiths teaches capability wherein presentation formulator formulates the one or more tailored store screens to be displayed on the shopper's computer during the current communication to contain at least one of a direct response advertisement area and an impulse advertisement area, containing information on at least one of merchandise and services related at least in

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part to the location of the shopper's computer at the time of the current communication, as determined by the shopper data collector.

Regarding claims 74 – 75, Bandera in view of Griffiths teaches capability wherein location of the shopper's computer at the time of the current communication is determined using a publicly accessible database like Domain Naming System.

Regarding claims 93 – 96, Bandera in view of Griffiths teaches capability to determine additional information about the computer by reading the additional information from a publicly accessible database like Domain Name System (DNS).

Regarding claim 97, Bandera in view of Griffiths teaches capability to determine geographical location of the computer as the additional information about the computer.

Regarding claim 98, Bandera in view of Griffiths teaches capability to send the at least one tailored screen to the computer via the network during the current communication session.

***Conclusion***

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig  
Examiner  
Art Unit 3629

May 31, 2007